A

See Hau Global Sdn Bhd v Mah Sing Plastics Industries Sdn Bhd

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COURT OF APPEAL (PUTRAJAYA) — CIVIL APPEAL NO W-02(IPCV)(W)-1863–11 OF 2014
ALIZATUL KHAIR, NALLINI PATHMANATHAN AND ZABARIAH YUSOF JJCA
25 JULY 2017

C

Trade Marks — Patents — Validity — Validity of registered patent — Application challenging — Whether defendant had exclusive right to manufacture, distribute and sell wing-shaped pallets in Malaysia — High Court dismissed plaintiff's application to invalidate patent but held that plaintiff's wing-shaped pallet did not infringe patent — Defendant appealed against finding that plaintiff's model did not infringe patent — Plaintiff cross-appealed against dismissal of its application — Whether trial judge erred in limiting plaintiff's claim to wing-shaped integer of patent — Whether plaintiff sought to invalidate each of five claims in patent — Whether patent lacked novelty and was not anticipated by prior art — Whether patent involved an inventive step — Whether trial judge erred in excluding wholly from consideration the evidence of plaintiff's experts — Whether issue raised in this appeal by defendant became academic

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Both Mah Sing Plastics Industries Sdn Bhd ('the plaintiff') and See Hau Global Sdn Bhd ('the defendant') were in the business of manufacturing, selling and distributing of pallets. The defendant was the registered owner of an invention referred to as a wing-shaped pallet constructed for handling and storing loads ('the MY-055 patent'). With the MY-055 patent, which was granted under the Patents Act 1983 ('the Act') on 28 February 2013, the defendant claimed an exclusive right to manufacture, distribute and sell wing-shaped pallets in Malaysia. The plaintiff was aggrieved by the defendant's stance as it prohibited the plaintiff from manufacturing, distributing and selling its wing shaped pallets in Malaysia, which it had been doing since 2012. Consequently, the plaintiff filed a suit against the defendant challenging the validity of the MY-055 patent under s 56(2)(a) of the Act, with an additional prayer that the plaintiff's wing shaped pallet did not infringe the MY-055 patent. It was the plaintiff's case that the MY-055 patent was not novel as it was anticipated by prior art, did not involve any inventive steps, did not involve any inventive idea and lacked sufficiency and clarity in its description to support the claim. The defendant, on the other hand, maintained that the MY-055 patent was valid by reason that the features claimed in all of the five claims in the patent were novel and inventive and more particularly that the MY-055 patent provided technical contributions or advantageous effects over prior art documents

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collectively. The trial judge found that the MY-055 patent was novel and was not anticipated by prior art and that it involved an inventive step that was not obvious to a person having ordinary skill in the art. The High Court thus dismissed the plaintiff's claim to invalidate the MY-055 patent with costs but found that the plaintiff's claim for invalidation was limited to the wing shape of the pallet registered under the MY-055 patent. This meant that the plaintiff's wing pallet model did not infringe the MY-055 patent and the plaintiff could manufacture, distribute and sell that model ('the N4-1311SLW model'). Both the plaintiff and the defendant appealed against this decision. The defendant filed an appeal against the trial judge's finding that the plaintiff's model N4-1311SLW did not infringe the MY-055 patent, while the plaintiff cross-appealed against the decision in respect of the dismissal of its claim for the invalidation of the MY-055 patent.

Held, allowing the cross-appeal and dismissing the appeal with costs of RM150,000 to the plaintiff/respondent:

(1) A perusal of the plaintiff's statement of claim disclosed that its claim for invalidation was not limited to the wing-shaped integer of the MY-055 patent. It was clear from the particulars of objections in the statement of claim that the plaintiff sought to invalidate each of the five claims in the MY-055 patent on the grounds that they were neither novel nor inventive. As such, the trial judge erred in limiting the plaintiff's grounds of objections to the feature/integer of the wing shape of the pallet registered under the MY-055 patent (see paras 21–25).

(2) Proof that an invention was not new and lacked novelty because it had been anticipated by prior art constituted a ground for the invalidation of such an invention. In order to constitute anticipation, that prior document should also be an enabling document in the sense that it should not only identify exactly the invention but should do so in a way that would enable persons who were skilled in the art to recognise, perceive and work the invention as claimed. In the instant case, it was an undisputed fact that the MS ISO 445, the defendant's pallet and the plaintiff's pallet were the documents that individually constituted part of the prior art. In line with the authorities, a comparison had to be made between the claims in the MY-055 patent and each of the items considered as part of the prior art namely the MS ISO 445, the defendant's pallet and the plaintiff's pallet individually, to determine whether each of the prior art anticipates the claims in the MY-055 patent. In the present case it was clear from the evidential records that the plaintiff's expert witnesses testified extensively that the MY-055 patent lacked novelty, in that each of the features of the MY-055 patent was to be found in ISO 445, which is adopted by the Malaysian Standards, and also to be found in the plaintiff's industrial design without reference to any other prior art. In the circumstances the trial judge had erred in

concluding that 'the plaintiff had failed to prove on a balance of probability that any one single prior art contained all the special features and their combination'. The evidence showed that each of the three prior art by itself, contained the features of the claims in the MY-055 patent. Further, in his evidence the inventor of the wing pallet registered as the MY-055 patent effectively conceded that the he had not invented any of the essential features of his 'invention' individually. Thus, having considered the evidence as a whole, it was clear that the MY-055 patent lacked novelty as it had been anticipated by prior art. The fact that the MY-055 patent lacked novelty in itself was sufficient to allow the cross-appeal (see paras 30–32, 34–36, 38–49 & 94–95).

(3) In determining whether the trial judge had erred in concluding that the MY-055 patent involved an inventive step it was necessary to adopt the four-stage test laid down in the case of *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59. In the instant case, although the trial judge cited the *Windsurfing* case she failed to appreciate the purpose and application of the evidence of the plaintiff's experts. In actual fact the plaintiff's experts would have educated the court as to the nature of the skilled unimaginative addressee, the common general knowledge at the material time, and the way such a skilled man would approach the problem. However, the trial judge erred in excluding wholly from consideration the evidence of the plaintiff's experts. Based on the entirety of the evidence on record, it was obvious that the MY-055 patent did not embody or incorporate an inventive step (see paras 50–55, 60, 83–85 & 88).

(4) The issue raised in this appeal by the defendant was contingent upon the trial court's finding that the MY-055 patent was valid. As it has been concluded that the MY-055 patent was invalid, this issue became academic and redundant (see paras 96–98).

[Bahasa Malaysia summary

Kedua-dua Mah Sing Plastics Industries Sdn Bhd ('plaintif') dan See Hau Global Sdn Bhd ('defendan') dalam perniagaan membuat, menjual dan mengedar palet. Defendan adalah pemilik berdaftar ciptaan yang dirujuk sebagai palet berbentuk sayap yang dibuat untuk mengendali dan menyimpan beban ('paten MY-055'). Dengan paten MY-055 yang telah diberikan di bawah Akta Paten 1983 ('Akta tersebut') pada 28 Februari 2013, defendan menuntut hak eksklusif untuk membuat, mengedar dan menjual palet berbentuk sayap tersebut di Malaysia. Plaintif terkilan dengan pendirian defendan kerana ia menghalang plaintif daripada membuat, mengedar dan menjual palet bentuk sayapnya di Malaysia, yang telah dilakukannya sejak 2012. Akhirnya, plaintif telah memfailkan guaman terhadap defendan mencabar kesahan paten MY-055 di bawah s 56(2)(a) Akta tersebut, dengan permohonan tambahan bahawa palet berbentuk sayap plaintif tidak melanggar paten MY-055 tersebut.

Ia adalah kes plaintif bahawa paten MY-055 bukan semula jadi kerana ia telah dijangka oleh seni terdahulu, tidak melibatkan apa-apa langkah inovatif, tidak melibatkan apa-apa idea inventif dan tidak mempunyai kecukupan dan kejelasan dalam keterangan untuk menyokong dakwaannya. Defendan, sebaliknya, menegaskan bahawa paten MY-055 adalah sah oleh sebab ciri-ciri yang didakwa dalam kesemua lima tuntutan dalam paten itu adalah semula jadi dan inventif dan lebih khusus bahawa paten MY-055 mempunyai sumbangan teknikal atau kesan menguntungkan berbanding dokumen seni terdahulu secara kolektif. Hakim perbicaraan mendapati bahawa paten MY-055 adalah semula jadi dan tidak dijangka oleh seni terdahulu dan bahawa ia melibatkan langkah inventif yang tidak jelas kepada seseorang yang mempunyai kemahiran biasa dalam seni. Mahkamah Tinggi oleh itu menolak tuntutan plaintif untuk membatalkan paten MY-055 dengan kos tetapi mendapati tuntutan plaintif untuk pembatalan adalah terhad kepada bentuk sayap palet yang didaftarkan di bawah paten MY-055. Ini bermaksud bahawa model palet sayap plaintif tidak melanggar paten MY-055 dan plaintif boleh membuat, mengedar dan menjual model tersebut ('model N4-1311SLW'). Kedua-dua plaintif dan defendan telah merayu terhadap keputusan ini. Defendan telah memfailkan rayuan terhadap dapatan hakim perbicaraan bahawa model N41311SLW tidak melanggar paten MY-055, manakala plaintif telah merayu balas terhadap keputusan berkaitan penolakan tuntutannya untuk pembatalan paten MY-055.

Diputuskan, membenarkan rayuan balas dan menolak rayuan dengan kos RM150,000 kepada plaintif/responden:

(1) Penelitian kenyataan tuntutan plaintif menunjukkan bahawa tuntutannya untuk pembatalan tidak terhad kepada integer berbentuk sayap paten MY-055. Ia adalah jelas daripada butiran bantahan dalam kenyataan tuntutan yang dipohon plaintif untuk membatalkan setiap daripada lima tuntutan dalam paten MY-055 atas alasan bahawa sama ada ia tidak semula jadi atau inventif. Oleh itu, hakim perbicaraan terkhilaf dalam mengehadkan alasan plaintif untuk membantah ciri/integer bentuk sayap palet yang didaftarkan di bawah paten MY-055 tersebut (lihat perenggan 21–25).

(2) Bukti bahawa ciptaan tidak baru dan tidak semula jadi kerana ia telah dijangka oleh seni terdahulu merupakan alasan untuk pembatalan suatu ciptaan. Bagi tujuan untuk membentuk jangkaan, dokumen terdahulu tersebut juga patut suatu dokumen yang membolehkan dalam erti kata ia tidak hanya mengenal pasti dengan tepat ciptaan itu tetapi juga berbuat demikian dengan cara yang membolehkan seseorang yang berkemahiran dalam seni untuk mengiktiraf, melihat dan mengerjakan ciptaan sepertimana didakwa. Dalam kes ini, ia fakta yang tidak dipertikaikan bahawa MS ISO 445, palet defendan dan palet plaintif adalah dokumen-dokumen yang secara berasingan merupakan sebahagian

daripada seni terdahulu. Selaras dengan autoriti-autoriti, satu perbandingan telah dibuat antara tuntutan-tuntutan dalam paten MY-055 dan setiap item yang diambil kira sebagai sebahagian daripada seni terdahulu iaitu MS ISO 445, palet defendan dan palet plaintif secara berasingan, untuk menentukan sama ada setiap seni terdahulu menjangkakan tuntutan-tuntutan dalam paten MY-055. Dalam kes ini ia adalah jelas daripada rekod keterangan bahawa saksi-saksi pakar plaintif telah memberi keterangan secara meluas bahawa paten MY-055 tidak semula jadi, yang mana setiap ciri-ciri paten MY-055 tidak didapati dalam ISO 445, yang diguna pakai oleh Piawai Malaysia, dan juga didapati dalam rekabentuk industri plaintif tanpa rujukan kepada mana-mana seni terdahulu yang lain. Dalam keadaan itu hakim perbicaraan telah tekhilaf dalam membuat kesimpulan bahawa 'the plaintiff had failed to prove on a balance of probability that any one single prior art contained all the special features and their combination'. Keterangan menunjukkan bahawa setiap daripada tiga seni terdahulu dengan sendirinya, mengandungi ciri-ciri tuntutan-tuntutan dalam paten MY-055. Selanjutnya, dalam keterangannya pencipta palet sayap berdaftar sebagai paten MY-055 secara efektif mengakui bahawa dia tidak mencipta apa-apa ciri-ciri penting dalam 'invention'nya secara berasingan. Oleh itu, setelah mengambil kira keterangan secara keseluruhan, ia adalah jelas bahawa paten MY-055 tidak semula jadi kerana ia telah dijangka oleh seni terdahulu. Fakta bahawa paten MY-055 tidak semula jadi dengan sendirinya mencukupi untuk membenarkan rayuan balas (lihat perenggan 30–32, 34–36, 38–49 & 94–95).

(3) Dalam menentukan sama ada hakim perbicaraan terkhilaf dalam membuat kesimpulan bahawa paten MY-055 melibatkan langkah inventif ia adalah perlu untuk mengguna pakai ujian empat-peringkat yang dinyatakan dalam kes *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59. Dalam kes ini, meskipun hakim perbicaraan memetik kes *Windsurfing* beliau gagal untuk memahami tujuan dan pemakaian keterangan pakar-pakar plaintif. Pada hakikat sebenar pakar-pakar plaintif dapat menerangkan kepada mahkamah berhubung sifat penerima berkemahiran yang tidak imaginatif, pengetahuan am biasa pada masa matan, dan cara seseorang yang berkemahiran berhadapan dengan masalah itu. Walau bagaimanapun, hakim perbicaraan terkhilaf dalam mengecualikan secara keseluruhan daripada pertimbangan keterangan pakar-pakar plaintif. Berdasarkan keseluruhan keterangan atas rekod, adalah jelas bahawa paten MY-055 tidak merangkumi atau menggabungkan langkah yang inventif (lihat perenggan 50–55, 60, 83–85 & 88).

(4) Isu yang ditimbulkan dalam rayuan ini oleh defendan adalah kontingen kepada dapatan mahkamah perbicaraan bahawa paten MY-055 adalah sah. Oleh kerana ia telah disimpulkan bahawa paten MY-055 adalah

tidak sah, isu ini menjadi akademik dan lewah (lihat perenggan 96–98).]

Notes

For a case on validity, see 12(2) *Mallal's Digest* (5th Ed, 2017 Reissue) para 2958.

Cases referred to

Biogen Inc v Medeva plc [1997] RPC 1, HL (refd)
British Celanese Ltd v Courtaulds Ltd (1935) 52 RPC 171, HL (refd)
British Thomson-Houston Co Ltd v Stonebridge Electrical Co Ltd (1916) 33 RPC 166, Ch D (refd)
Raychem Corpn's Patent, Re [1998] RPC 31 (refd)
Sanofi-Aventis (M) Sdn Bhd & Anor v Fresenius Kabi (M) Sdn Bhd & Anor [2012] 4 CLJ 532, HC (refd)
Seng Kong Shutter Industries Sdn Bhd & Anor v SKB Shutters Manufacturing Sdn Bhd [2014] 5 MLJ 98; [2014] 4 CLJ 1037, CA (refd)
SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor [2015] 6 MLJ 293, FC (refd)
Synthon BV v SmithKline Beecham plc [2006] 1 All ER 685, HL (refd)
The General Tire & Rubber Company v The Firestone Tyre and Rubber Company Limited and others [1972] RPC 457, CA (refd)
Windsurfing International Inc v Tabur Marine (Great Britain) Ltd [1985] RPC 59, CA (folld)
Wood and Amcolite Ltd v Gowshall Ltd (1936) 54 RPC 37, CA (refd)

Legislation referred to

Patents Act 1983 ss 14, 15, 56(2)(a)

Appeal from: Civil Suit No 22IP-24–08 of 2013 (High Court, Kuala Lumpur)

Pang Yeow Choy (Daniel Bock with him) (YC Pang, Chong & Gordon) for the appellant.
Timothy Siaw (Raghuram S with him) (Shearn Delamore & Co) for the respondent.

Alizatul Khair, Nallini Pathmanathan and Zabariah Yusof JJCA:

INTRODUCTION

[1] This is an appeal against the decision of the High Court in respect of a claim seeking to invalidate a patent, namely Malaysian Patent No MY-148055-A ('MY-055') registered by the defendant, who is the appellant here. After a full trial the High Court made the following orders:

(a) the plaintiff's claim for the invalidation of MY-055 is dismissed. The plaintiff is the respondent in this appeal; and

(b) the learned trial judge allowed the plaintiff's prayer in para 19(c) of the statement of claim as amended, which reads as follows:

> A declaration that the manufacture, importation, distribution, stocking, supply, sale and/or offering to supply or sell the Plaintiff's wing shaped pallets, limited only to model N4-131-1SLW manufactured by the Plaintiff or its licensees or distributors does not constitute an infringement of any and all of the claims of Malaysian Patent No MY-148055-A.

[2] Both the plaintiff and the defendant appealed against this decision. The defendant filed an appeal against the grant of prayer 19(c) as amended, in respect of the amendment, as well as the grant of the said prayer.

[3] The plaintiff cross-appealed against the decision in respect of the dismissal of its claim for the invalidation of MY-55.

[4] The parties will be referred to as follows:

(a) the appellant will be referred to as the defendant; and

(b) the respondent will be referred to as the plaintiff.

THE BACKGROUND FACTS

[5] The salient facts are set out comprehensively in the judgment of the learned trial judge and we adopt the same here.

[6] Both the plaintiff and the defendant are in the business of manufacturing, selling and distributing of pallets.

[7] The defendant is the owner of the MY-055 patent which was invented by Cheah Chee Chon ('DW1'), in respect of an invention entitled 'Wing-Shaped Pallet for Handling & Storing Loads'. The MY-055 patent was granted under the Patents Act 1983 on 28 February 2013 and is in force until 27 July 2030.

[8] A brief description of the MY-055 patent is set out as follows:

> The present invention generally relates to a pallet utilized for handling and storing loads. More particularly, a wing-shaped pallet constructed for handling and storing loads including bag-packaged materials in cargo transportation, shipment and logistic services industries.

(54) **Title :** Wing-Shaped Pallet for Handling and Storing Loads

(57) **Abstract :**

A pallet (20) for handling and storing loads comprises a base (30) characterized by a plurality of vertical structure members (32) connected orthogonally with a horizontal support member (33); a plurality of treads (34) are coupled to the base (30) for producing coefficient friction between the base (30) and a conveying means; a planar platform (50) for receiving loads, having greater dimension than the base; a plurality of studs (31) is extending perpendicularly from every intersect point formed by the vertical structure members (32) and horizontal support members (33) of the base (30). The studs (31) are permanently coupled to the planar platform (50) forming a wing-shaped pallet (20) which have a high strength to weight ratio.

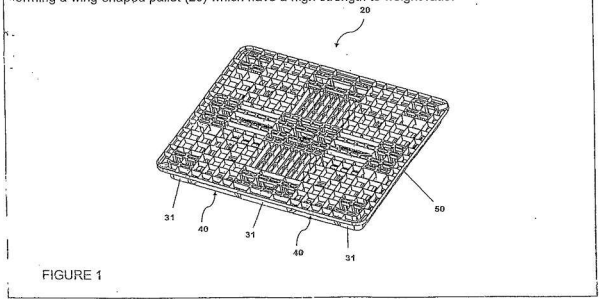


FIGURE 1

CROSS SECTION OF
Patent No. MY-148055

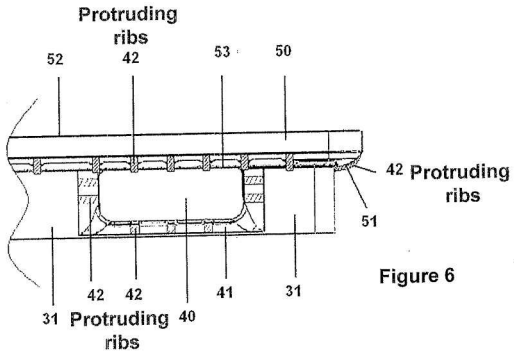


Figure 6

intraco pallet™
An order of Power & Performance™

[9] There are five claims in the MY-055 patent. Claim 1 of the MY-055 patent is a product claim that is directed to a wing-shaped pallet. Claims 2–5 are dependent on claim 1. The claims read as follows:

Claim 1

A wing-shaped pallet (20) for handling and storing loads, comprising of:

A base (30) characterized by a plurality of vertical structure members connected

A orthogonaliy with at least one horizontal support member (33), a plurality of treads on the bottom surface of the horizontal support member (33) for producing friction between said base (30) and a conveying means;

A planar platform (50) including bottom a surface (53) and a top surface (52) for receiving loads, having greater dimension than the base (30) thereby forming an overhanging area;

B

A plurality of studs (31) extending perpendicular from base (30) each positioned at every intersection of the vertical structure member (32) and the horizontal support member (33), wherein said studs (31) are coupled to the bottom surface (53) of the planar platform (50);

C

A plurality of anti-slip means (60) mounted on the base, the top surface (52) and the bottom surface (53) of planar platform (50); Wherein said anti-slip means mounted on the bottom surface of the planar platform (50) provide means for preventing slippage of fork tines;

D

Wherein the areas in between of the studs (31) form hollow channels (40) with chamfers for receiving fork tines;

Wherein the chamfers (41) and the overhanging area (51) may *further include* a *protruding ribs (42) to reinforce said planar platform (50) and to guide the entry of the fork tines across the chamfers (41).*

E

Claim2

A wing-shaped pallet (20) for handling and storing loads according to claim 1 wherein the planar platform (50) for receiving load may include a plurality of cavities.

F

Claim 3

A wing-shaped pallet (20) for handling and storing loads according to claim 1 wherein the wing-shaped pallet (20) can be made from any material, preferably thermoplastic resin materials.

G

Claim4

A wing-shaped pallet (20) for handling and storing according to claim 1 wherein the wing- shaped pallet has high strength to weight ratio.

H Claim 5

A wing-shaped pallet (20) for handling and storing loads according to claim 1 wherein the plurality of ribs (42) that protrudes from said chamfers (41) may have variable configurations.

I

[10] The following pages provide in diagrammatic form the component features of the pallets:

3.7
two-way pallet
two-way entry pallet
flat pallet permitting the entry of the fork arms of forklift trucks and pallet trucks from two opposite directions only

See Figure 8.

3.7
palette à deux entrées
palette plate ne permettant le passage des bras de fourche des transpalettes et chariots élévateurs que sur deux côtés opposés

Voir Figure 8.

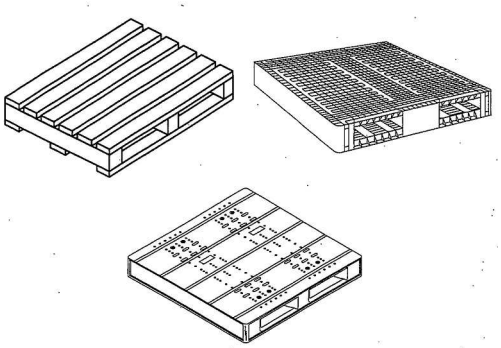


Figure 8 — Two-way pallets
Figure 8 — Palettes à deux entrées

6.5 Chamfers

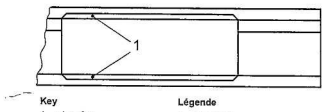
6.5.1
chamfer
bevel on the top edges of the **bottom deck**, bottom boards or bottom edges of the **top deck** to facilitate the passage of fork-arm wheels of a pallet truck

See Figure 49.

6.5 Chanfreins

6.5.1
chanfrein
coupe en biseau sur les arêtes supérieures du **plancher inférieur** ou des éléments de plancher inférieurs ou les arêtes inférieures du **plancher supérieur**, pour faciliter le passage des galets des bras des fourches d'une transpalette

Voir Figure 49.



Key
1 chamfer

Légende
1 chanfrein

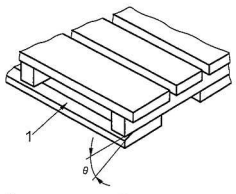
Figure 49 — Chamfer
Figure 49 — Chanfrein

6.5.2
continuous chamfer
chamfer along the complete length of the board

See Figure 50.

6.5.2
chanfrein continu
chanfrein sur toute la longueur de l'élément

Voir Figure 50.



Key
1 chamfer

Légende
1 chanfrein

Figure 50 — Continuous chamfer
Figure 50 — Chanfrein continu

A

B

C

D

E

MS ISO 445:2010

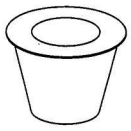


Figure 65 — Conical foot
Figure 65 — Pied conique

6.9 Other components

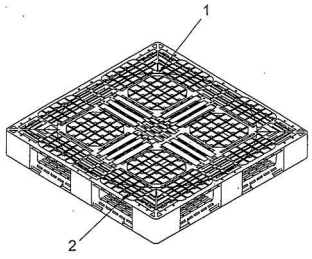
6.9.1
rib
reinforcing structure used to keep strength or rigidity without increasing thickness of each section and to prevent warping of wide flat areas of pallets

See Figure 66.

6.9 Autres composants

6.9.1
renfort
structure renforçant la résistance ou la rigidité sans augmenter l'épaisseur de chaque section et servant à empêcher le gauchissement de larges zones plates de palette

Voir Figure 66.



Key
1 grill structure
2 rib

Légende
1 structure grillagée
2 renfort

Figure 66 — Other components: grill structure and rib
Figure 66 — Autres composants: structure grillagée et renfort

F **[11]** The plaintiff began manufacturing and selling wing shaped pallets towards the end of 2012. The other manufacturer of plastic pallets is the defendant, See Hau Global Sdn Bhd.

G **[12]** On 20 June 2013, the defendant had published a warning notice in the Chinese Daily *Sin Chew Jit Poh* asserting its rights as the owner of the MY-055 patent. With the said MY-055 patent, the defendant claimed an exclusive right to manufacture, distribute and to sell wing-shaped pallets in Malaysia.

H **[13]** The plaintiff contends that it is aggrieved by this as it prohibits the plaintiff from manufacturing, distributing and selling its wing shaped pallets in Malaysia, which it has been doing since 2012.

I **[14]** The plaintiff instituted this suit as a pre-emptive measure against any legal actions on infringement in respect of the MY-055 patent and thereby challenging the validity of the MY-055 patent with an additional prayer that the plaintiff's wing shaped pallet does not infringe the MY-055 patent.

THE APPEAL AND THE CROSS-APPEAL

[15] The substantive part of this appeal relates to the cross-appeal, namely the invalidation of MY-055. We therefore propose to deal with the cross-appeal first.

The cross-appeal

[16] The cross-appeal relates to the invalidation of MY-055 under s 56(2)(a) of the Patents Act 1983 (Act 291) ('the PA') which provides as follows:

> Section 56 Invalidation of patent.
>
> (2) The Court shall invalidate the patent if the person requesting the invalidation proves —
>
> (a) that what is claimed as an invention in the patent is not an invention within the meaning of section 12 or is excluded from protection under section 13 or subsection 31(1) or is not patentable because it does not comply with the requirements of sections 11, 14, 15 and 16; ...

[17] The plaintiffs case may be summarised as follows, namely that MY-055:

(a) is not novel as it is anticipated by prior art;

(b) does not involve any inventive steps, as the invention is obvious to a person having ordinary skill in the art and by having regard to the common general knowledge in the related field;

(c) does not involve any inventive idea; and

(d) lacks sufficiency and clarity in its description to support the claim.

[18] The defendant maintains that MY-055 is valid by reason that the features claimed in all of the claims in the patent are novel and inventive. More particularly it is pleaded that MY-055 is valid because:

(a) MY-055 provides technical contributions and/or advantageous effects over prior art documents collectively;

(b) these technical contributions and/or advantageous effects are set out in the specifications, the features of which include:

High strength and light weight for handling and storing loads:

(i) high stability;

(ii) light weight and high stiffness/rigidity;

(iii) prevention of pallet deformation with a plurality of protruding ribs; and

A (iv) prevention of pallet deformation with a wing structure or overhanging areas;

(c) it is contended that the specification does disclose the invention in a manner, which is sufficiently clear and complete for the invention to be
B evaluated and carried out by a person having ordinary skill in the art.

The judge's findings

[19] In relation to the cross-appeal the learned judge made the following
C findings:

(a) the plaintiff's claims for invalidation were to be limited to those contained in para 5.1 of the statement of claim. This meant that the plaintiff's objections were limited to the 'wing feature' of the pallet and did not extend to the plurality of treads and anti-slip stud features;
D

(b) the plaintiff had failed to establish on a balance of probabilities that MY-055 had been anticipated in a single document. This was necessary to establish novelty;

E (c) on the issue of an inventive step the learned judge rejected the evidence of PW3 and PW4 on the grounds that as the 'contributors and inventors of pallets', they did not fall within the requirement of the 'unimaginative skilled person without a scintilla of inventiveness' in the field of pallet design and manufacture; and

F (d) therefore the learned judge concluded that MY-055 is novel, not obvious nor lacking in an inventive step. The plaintiff's claim to invalidate MY-055 was therefore dismissed with costs.

Issues
G

[20] The issues that arise for consideration in this cross-appeal are as follows:

(a) was the learned judge correct in limiting the plaintiff's claim to para 5.1 of the statement of claim? and
H

(b) was the learned judge correct in concluding that:

(i) MY-055 is novel and is not anticipated by prior art as set out in s 14 of the Patents Act 1983 ('the PA')? and

I (ii) MY-055 involves an inventive step in that it is not obvious to a person having ordinary skill in the art as provided for in s 15 of the PA and having regard to the common general knowledge?

Issue (a): Was the learned judge correct in limiting the plaintiff's claim to para 5.1 of the statement of claim?

[21] A perusal of the plaintiff's statement of claim discloses that its claim for invalidation is not limited to the wing-shaped integer of MY-055. This is evident from:

(a) paras 9, 10, 11, 12, 13 and 14 of the statement of claim; and

(b) paras 5.1, 9, 10, 13 and 17 of the particulars of objections and/or grounds of invalidity of Malaysian Patent No MY-148055-A.

[22] These paragraphs deal with, inter alia, novelty, inventiveness and sufficiency of the claims relating to MY-055. The fact that the claim of invalidity extends to each of the five claims of MY-055 is clear from paras 1–5 of the particulars of objections. Paragraph 5 provides:

> The alleged invention claimed in each claim of MY-055 patent, in particular, claims 1 to 5, is not new or novel within the meaning of sections 11 and 14(1) of the Patents Act 1983.

[23] It is therefore clear that the plaintiff sought to invalidate each of the claims in MY-055 on the grounds that they were neither novel nor inventive. A further ground was that each and every claim lacked support, sufficiency and clarity.

[24] Therefore we concur with learned counsel for the plaintiff that the plaintiff was challenging not only the 'wing feature' of MY-055 separately, but also the combination of the plurality of treads and anti slip features of the pallet as expressly pleaded in the statement of claim.

[25] We are therefore of the view that the learned judge erred in limiting the plaintiff's grounds of objections to the feature/integer of the wing shape of the pallet registered under MY-055. It appears that the learned judge did not peruse or give any or adequate consideration to the statement of claim. In her judgment, the learned judge referred to para 5.1 of the statement of claim when she was in fact referring to para 5.1 of the particulars of objection/grounds of invalidity.

Issue (ii): Was the learned judge correct in concluding that

(a) MY-055 is novel and is not anticipated by prior art as set out in s 14 of the Patents Act 1983 ('the PA')? and

(b) MY-055 involves an inventive step in that it is not obvious to a person having ordinary skill in the art as provided for in s 15 of the PA and having regard to the common general knowledge?

Novelty

[26] The learned judge concluded on this issue that the plaintiff had failed to prove on a balance of probabilities that any one single prior art contains all the special features and their combination as claimed by the defendant in MY-055. She further concluded the plaintiff had sought to mosaic numerous prior art in order to show that MY-055 is not novel. As combining or seeking to mosaic is against established principles in relation to novelty, she concluded that MY-055 was indeed novel when it was registered on 27 July 2010.

The position in law on novelty

[27] The position in law on novelty is set out in s 14 of the PA which stipulates as follows:

Section 14 Novelty

(1) An invention is new if it is not anticipated by prior art.

(2) Prior art shall consist of —

(a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention;

(b) the contents of a domestic patent application having an earlier priority date than the patent application referred to in paragraph (a) to the extent that such contents are included in the patent granted on the basis of the said domestic patent application.

(3) A disclosure made under paragraph (2)(a) (shall be disregarded) —

(a) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;

(b) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title;

(c) if such disclosure is by way of a pending application to register the patent in the United Kingdom Patent Office as at the date of coming into force of this Act.

(4) Subsection (2) shall not exclude the patentability of any substance or composition, comprised in the prior art, for use in a method referred to in paragraph 13(1)(d), if its use in any such, method is not comprised in the prior art.

[28] In short, s 14 provides that an invention is neither novel nor anticipated if: A

(a) the invention is disclosed wholly in a prior published enabling document; or

(b) if by following the teachings of and putting the invention disclosed in the prior published document into practice, it would infringe the patent under attack. B

[29] This is borne out, inter alia, by Sachs LJ in *The General Tire & Rubber Company v The Firestone Tyre and Rubber Company Limited and others* [1972] RPC 457 at p 485 ('General Tire'): C

> To determine whether a patentee's claim (In the Malaysian context, 'invention') has been anticipated by an earlier publication with the patentee's claim. The earlier publication must, for this purpose, be interpreted as at the *date of its publication*, having regard to the surrounding circumstances which then existed, and without regard to subsequent events. If the earlier publication, so construed, discloses *the same device which the patentee by his claim, so construed, asserts that he has invented, the patentee's claim has been anticipated, but not otherwise*. D
>
> The earlier publication and the patentee's claim must *be construed as they would be at the respective relevant dates (ie date of publication) by a reader skilled in the art to which they relate having regard to the state of knowledge (the usage of 'state of knowledge' clearly indicates the need for common general knowledge to be conscious at the back of the person skilled in the art's mind when construing documents) in such at the relevant date* ... If the art is one having a highly developed technology, the notional skilled reader to whom the document is addressed may not be single person but a team, whose combined skill would normally be employed in that art in interpreting and carrying into effect instructions such as those which are contained in the document to be construed. E F
>
> We have already described the composite entity deemed to constitute the notional skilled addressee. G
>
> If the prior inventor's publication contains a clear description of, or clear instruction to do or make, something that would infringe the patentee's claim, if carried out after the grant of the patentee's claim, the patent's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated; *but if carrying out the directions contained in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent where valid, would constitute an infringement of the patentee's claim, the circumstance demonstrate that the patentee's claim has in fact been anticipated.* H
>
> ... To anticipate the patentee's claim, the prior publication must contain *clear and unmistakable directions* to do what the patentee claims to have invented: ... A signpost however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee. I

[30] To constitute anticipation, that prior document must also be an enabling document in the sense that it must not only identify exactly the invention, it must do so in a way that will enable persons who are skilled in the art to recognise, perceive and work the invention as claimed.

[31] In other words both must be cumulatively met to make out a case of anticipation.

[32] The House of Lords in *Synthon BV v SmithKline Beecham plc* [2006] 1 All ER 685 at para 26 explained:

> 'Enablement' means that the ordinary skilled person would have been able to perform the invention which satisfies the requirement of disclosure.

At para 24, Lord Hoffman explained:

> Although it is sometimes said that there are two types of anticipatory disclosure: a disclosure of the patented invention itself and a disclosure of an invention which, if performed, would necessarily infringe the patented invention, they are both aspects of a single principle, namely that anticipation requires prior disclosure of subject matter which, when performed, must necessarily infringe the patented invention.

[33] In the Malaysian case of *Seng Kong Shutter Industries Sdn Bhd & Anor v SKB Shutters Manufacturing Sdn Bhd* [2014] 5 MLJ 98; [2014] 4 CLJ 1037, this court adopted the test laid out in *General Tire* at paras 18–19.

Aziah Ali JCA stated as follows:

> [18] Novelty is not something which can be proved or established, only its absence can be proved or established. The determination of novelty of an invention strictly consists of consideration of two aspects — the invention claimed for protection and the prior art information available in the concerned field. The knowledge of an invention in order to be considered as relevant prior art should satisfy any one or more of the following:
>
> (a) by the description of the invention in a published writing or document or in any tangible form;
>
> (b) by description of the invention in spoken words uttered in public, such a disclosure is known as oral disclosure; and
>
> (c) by the use of the invention in public or by putting the public in a position where any member of the public may access to it.
>
> The test for establishing the lack of novelty is that each and every ingredient element of the claimed invention must be present in a single prior art (see *Subbaram On Patent Law, Practices & Procedures* (2nd Ed)).
>
> [19] Proof that an invention is not new and lacks novelty because it has been

anticipated by prior art constitutes a ground for the invalidation of such invention (s 56(2) of the Act). The onus of proof lies, as regards each allegation, on the party launching the attack (*General Tire & Rubber Co*).

The instant case

[34] In the instant case it is not disputed by the defendant that the following document and pallets comprise part of the prior art:

(a) MS ISO 445;

(b) the defendant's pallet marked as exh P5; and

(c) the plaintiff's pallet marked as exh P11.

[35] Each of the items above individually constitutes prior art. Therefore in line with the authorities, a comparison is to be made between the claims in MY-055 and each of the items above, individually, to determine whether each of the prior art anticipates the claims in MY-055 (see *SKB Shutters*). As stated earlier, to constitute anticipation, each of the items above should also enable the ordinary skilled person to perform the invention, namely MY-055 (see *Synthon*).

[36] In the present case it is clear from the evidential records that PW3 and PW4 testified extensively that MY-055 lacks novelty. PW3, Wong Duen Yuan, is the product development manager of the plaintiff. His role includes the planning, design, development and implementation of plastic products and designs for various products including plastic pallets, plastic containers, and plastic furniture. He also oversaw the intellectual property aspects of pallet design by securing industrial design protection over designs created by the plaintiff. At the time of trial, he had seventeen years experience in the design and manufacturing of plastic pallets. He also has the requisite qualifications. He is a member of the 'Working Group on Pallets' at SIRIM since 2003.

[37] PW3 testified in the course of his evidence that each of the features of MY-055 is to be found in ISO 445, which is adopted by the Malaysian Standards. This is borne out by his testimony in examination-in-chief as seen below:

PC	Can you confirm all these features are standard features under the Malaysian Standard IS0445
PW3	All these features are standard features for all pallets. All these are common for all plastic pallets used in the market.
PC	Can you confirm for us that these documents referred to wing shape?
PW3	This document refers to the wing shape.
PC	Does it refer to anti-slip?

PW3	Yes.
PC	Does it refer to the chamfers?
PW3	The chamfers. The block. And the anti-slip. All these are standard components described in this standard.
PC	Just to confirm, the Malaysian Standard refer to wing-shape, anti-slip, ribs, chamfers?
PW3	Correct.

[38] Although this evidence was challenged in cross-examination, the witness maintained his stance. It is evident from the foregoing that PW3 undertook a comparison of all the claims in MY-055 with ISO 445. There was no attempt to combine or mosaic the prior art, which was only IS0-445 (adopted by the Malaysian Standards).

[39] Similarly a comparison was then undertaken between all the claims in MY-055 and MY09-013155-0101 (Industrial Design Registration registered on 13 December 2010) and marked P11 . Again PW3 confirmed that similar features could be found between the claims in MY-055 and P11, without reference to any other prior art. Again there was no attempt to combine or mosaic the design of P11 and any other prior art.

[40] This can be seen below from the examination-in-chief of PW3:

J	Marked as P11.
PC	Now I show you this document, can you please tell us what this document is?
PW3	This is certificate tor industrial design registration with number MY09-013155-0101. So this design registration is filed on 14th December 2009, and approved on 13th December 2010.
PC	Can you confirm that this industrial design registration corresponds with this particular pallet?
PW3	Yes.
PC	Can you tell us that production date of this particular pallet?
PW3	Jan 2010.
PC	Can you point out where can find this anti-slip?
PW3	The anti-slips are located on the top surface of the planar platform, the bottom surface of the planar platform, and in the bottom of the channels.
PC	Can you tell us where are the treads of this pallet?
PW3	The treads are located at the top edge of the bottom surface and the bottom edge of the top surface.
PC	Can you show us the chambfers?
PW3	Located at the bottom.

[41] During the course of cross-examination as seen below, PW3 was asked

whether protruding ribs at the chamfers could be found in any of the other prior art produced before the court. PW3 maintained that prior pallets produced by the defendant had protruding ribs:

DC	This is what I said. My client has provided very specific features that contained in his patent, at the chamfers, at the overhanging part there are protruding ribs. Where can you find this special features in my client's patent in any of the prior arts that you produced before the court, save for our client's own products?
PW3	Just now you mentioned about the prior lntraco pallets have protruding ribs.
J	Just put in your submission.

[42] In re-examination as shown below, reference was made to one of the defendant's pallets manufactured in 2009, marked P5. PW3 confirmed that protruding ribs were not a novel feature and comprised part of prior art.

Re-examination

PC	Refer to 105. Can you tell us what this pallet is?
PW3	This is lntraco See Hau pallet manufactured in 2009.
PC	How do you (know) that it is manufactured in 2009?
PW3	Because there was a trademark lntraco embossed pallet.
PC	And the date of manufacture?
PW3	Jan 2009.
PC	Are these protruding ribs new?
PW3	No this is not new.
PC	Form part of prior arts?
PW3	Yes.

[43] Again the comparison was between the claims in MY-055 and separate prior art. There was no combination nor attempt to mosaic the prior art in PW3's evidence.

[44] Given the foregoing we are of the view that the learned judge erred in concluding that 'the plaintiff had failed to prove on a balance of probability that any one single prior art contains all the special features and their combination'. The evidence shows that each of the three prior art by itself, contained the features of the claims in MY-055. This evidence which may be gleaned from PW3's testimony was not considered at all by the learned judge. In this context too, the learned judge erred in failing to give any consideration to the evidence on the record.

[45] Thirdly, the learned trial judge also erred in concluding that there was

an attempt by the plaintiff to mosaic the prior art in order to establish novelty. As is clear from PW3's evidence this is not the case. Each prior art was compared individually with the claims in MY-055.

[46] Further, S01's evidence in cross-examination shows that he effectively conceded that the he had not invented any of the essential features individually. He claimed that only the protruding ribs around the chamfers of his pallet and around the top planar were his 'invention':

PC	So now you're saying you did not invent treads.
SD1	No, I didn't.
PC	You did not invent treads. So you're now saying that you invented something with a combination of features. Okay, and you've identified 3 essential features which are the treads, the protruding ribs and the anti-slip. Is that correct?
SD1	Yes.
PC	So, all these 3 features must be present in the pallet to infringe your patent?
	...
PC	3 features that you have identified as essential - protruding ribs, treads, anti-slip. You've said that these are essential features, right? You've conceded that you did not invent treads, so you've mentioned that it is a combination of these 3. So, all these 3 must be present to infringe your patent? You are claiming a monopoly here.
	...
PC	What are the features that you claim to have invented?
	...
SD1	I have incorporated treads and the anti-slip means and the wing shape designed, and I have improved on these features and incorporated it into my design, then I've also, together with the novel features of the protruding ribs, together, it works as one embodiment.
	...
PC	... Essentially, you are claiming anti-slips at the top, bottom and the bottom of the top planar, at those 3 places. Can you agree with me that anti-slips already exist in the market on 27.07.2010 on the top, bottom and bottom of the top planar surface – all these 3 places you can find anti-slip means in pallets out there in the market?
SD1	Yes.
PC	Plastic pallets?
SD1	Yes.
PC	So it's nothing new ...
	...
PC	... Mr Cheah, all planar surfaces have cavities, right?
SD1	Yeah. I mean, not all, but it's common.

PC	It is common, isn't it? Even as at 27.07.2010, pallets have cavities already, right?
SD1	Yes.
PC	So, nothing new there. Claim 3, can be made from any material, preferably thermoplastic resin materials. Most pallets are made from thermoplastic resin materials, right?
SD1	Right.
PC	Even as at 27.07.2010, plastic pallets were made from thermoplastic materials.
SD1	Yes.
PC	You have not in your patent description mentioned any new material that you have invented, right?
SD1	No.
	...
PC	You mentioned about the wing shaped pallet, from the chamfers and have suitable geometrical configuration. These are just the ribs that can form various geometric configurations, right?
SD1	These are protruding ribs, right.
PC	But you mentioned you didn't invent protruding ribs, right?
SD1	No, I invented this protruding ribs that is around our chamfers and around the top planar .
	...
PC	So, my question is just to confirm that this is a wing shaped pallet, and you have confirmed that there are ribs in this overhanging area. And it's a design patent, it's not a patent. Mr. Cheah, have you filed for any corresponding patent in any other country? This particular patent.
SD1	No.
PC	Is it because you cannot get a patent anywhere else?
SD1	No, we didn't do it within the 1 year grace.

[47] Having considered the evidence as a whole, we are satisfied that MY-055 lacks novelty as it has been anticipated by prior art.

[48] In this regard we are not convinced that SD1 'invented' protruding ribs around the chamfers of his pallet. Protruding ribs are not novel as they can be found in prior art. We are therefore constrained to reverse the finding of the learned judge on this issue.

[49] Having concluded that the claims in MY-055 are not novel, this in itself is sufficient for us to allow the cross-appeal. However for purposes of completeness we go on to consider the issue of whether MY-055 contains an inventive step.

A Issue (ii)(b): Was the judge correct in concluding that MY-055 involves an inventive step in that it is not obvious to a person having ordinary skill in the art as provided for in s 15 of the PA and having regard to the common general knowledge?

B Section 15 PA provides as follows:

> An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraph 14(2)(a), such inventive step would not have been obvious to a person having ordinary skill in the
C art.

[50] This comprises the objective test that has to be applied in order to determine the issue.

D The judge's findings in relation to 'an inventive step'

[51] The learned judge found, in this respect that she could not accept the evidence of the plaintiff's witnesses, particularly PW3 and PW4, as they were not, in her view, unimaginative skilled persons in the field of pallet design and
E manufacturing. She concluded that 'something obvious to them might not be obvious to a skilled man with no ability and imagination to invent in the field of art.' Earlier on she had found that PW3 and PW4 were skilled persons with 'high capability and imagination' who could 'invent' pallets.

F **[52]** *Terrell on the Law of Patents* (15th Ed) published by Sweet & Maxwell at para 7.26 at p 174 states as follows:

> The primary evidence is therefore that of an expert, who can give evidence as to the nature of the skilled addressee, the body of knowledge (the so-called common
G general knowledge) which he would possess and the way in which such a skilled man would, as a matter of routine, approach problems. He can also identify steps which he believes would require a degree of lateral thinking and hence not be obvious to the skilled man.

H **[53]** The approach to be adopted in construing from the expert's evidence whether an inventive step is obvious is set out in the four stage test laid down by Oliver LJ in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59. *Terrell* sets out the four questions thus:

(1) First, the court identifies the inventive concept embodied in the patent in
I the suit.

(2) Next, the court will assume the mantle of the normally skilled but unimaginative addressee in the art at the relevant date and will impute to him what was at that date, common general knowledge in the art in question.

(3) The court should then identify what, if any, differences exist between the matters cited as being 'known or used' and the alleged invention.

(4) Finally the court has to decide whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they required any degree of invention.

[54] In the instant case, the learned judge although citing *Windsurfing*, failed to apply the case on the basis that PW3 and PW4 were not unimaginative skilled persons. To our minds the learned judge failed to appreciate the purpose and application of the evidence of the plaintiff's experts, PW3 and PW4.

[55] As stated in *Terrell*, the evidence of PW3 and PW4 served the purpose of educating the court, as to the nature of the skilled addressee, the common general knowledge at the material time, and the way in which such a skilled man would approach the problem.

[56] This approach has been adopted in numerous cases including *SKB Shutters* by this court and approved by the Federal Court on appeal.

[57] In the Court of Appeal, Aziah Ali JCA stated as follows:

> [30] The primary evidence is therefore that of an expert, who can give evidence as to the nature of the unimaginative skilled addressee, the body of knowledge (the so-called common general knowledge) which he would possess and the way in which such a skilled man would, as a matter of routine, approach problems. He can also identify steps which he believes would require a degree of lateral thinking and hence not be obvious to the skilled man *(Terrell on the Law of Patents* (15th Ed)).

[58] In the Federal Court, Zulkefli Ahmad Makinudin CJ (Malaya) stated as follows:

> [38] On the said questions (5) and (6) posed by the appellant we are of the view the general principles relating to the construction of patent claims and the role to be played by the 'experts' are well established. The function of the expert is to educate the court in technology and that they come as teachers, as makers of the mantle for the court to don. For that purpose it does not matter if they do not approximate a person skilled in the art (see the case of *Technip France SA's Patent*). As such, clearly the court can construe patent claims without the assistance of a person skilled in the art. Any assistance required is from an expert and he need not approximate a skilled person.
>
> [39] It is our judgment that the Court of Appeal was entitled to construe the claims of the appellant's patent and compare them with the prior art. Any assistance required on the technology, technical terms and common general knowledge had been led through the evidence of DW3, the respondents' expert at trial, whose evidence was before the Court of Appeal.

[59] At para 41 of the Federal Court decision in *SKB Shutters* it is expressly stipulated that the evidence of experts may be utilised in determining the element of obviousness in relation to a patent:

> 41 We are of the considered view that as the experts who educate the court on technology, technical terms and common general knowledge do not have to approximate persons skilled in the art, the Court of Appeal was entitled to hold that neither DW3 (the respondents' experts) nor PW1 (the appellant's expert) were 'unimaginative skilled addressees' and yet make reference to their evidence on technical terms and common general knowledge when assessing if the claims of a patent were obvious.

[60] As such, the learned judge erred in excluding wholly from consideration the evidence of PW3 and PW4. They are in fact the experts who will educate the court as to the nature of the skilled unimaginative addressee, the common general knowledge at the material time, and the way such a skilled man would approach the problem. This would then enable the court to assume the mantle of the notional addressee to then determine the issue of obviousness. However the issue of obviousness has to be considered in the light of the common general knowledge at the relevant date.

[61] Prior to considering the evidence of PW3 and PW4 therefore, we set out the position in law in relation to common general knowledge.

COMMON GENERAL KNOWLEDGE

[62] Common general knowledge is defined in *Terrell on the Law of Patents* (17th Ed), at p 211 as follows:

> The common general knowledge of the persons skilled in the art has been defined by the Board of Appeal as being normally represented by the content of encyclopedias, handbooks and dictionaries on the subject in question ...

And at p 207:

> Common general knowledge' means 'the information which, at the date of the patent in question, is common knowledge in the art or science to which the alleged invention relates, so as to be known to duly qualified persons engaged in that art or sciences.

[63] The foregoing definition was taken from the case of *British Thomson-Houston Co Ltd v Stonebridge Electrical Co Ltd* (1916) 33 RPC 166.

[64] In the more recent case of *Raychem Corpn's Patent, Re* [1998] RPC 31 Laddie J explained common general knowledge as follows:

> The common general knowledge is the technical background of the notional man in the art against which the prior art must be considered. This is not limited to material he has memorised and has at the front of his mind. It includes all that material in the field he is working in which he knows exists, which he would refer to as a matter of course if he cannot remember it and which he understands is generally regarded as sufficiently reliable to use as a foundation for further work or to help understand the pleaded prior art. This does not mean that everything on the shelf which is capable of being referred to without difficulty is common general knowledge nor does it mean that every word in a common text book is either. In the case of standard textbooks it is likely that all or most of the main text will be common general knowledge. In many cases common general knowledge will include or be reflected in readily available trade literature which a man in the art would be expected to have at his elbow and regard as basic reliable information.

[65] This definition of 'common general knowledge' was adopted and introduced as part of the Malaysian common law in *Sanofi-Aventis (M) Sdn Bhd & Anor v Fresenius Kabi (M) Sdn Bhd & Anor* [2012] 4 CLJ 532 (see also *General Tire*).

[66] As submitted by learned counsel for the plaintiff, it is not disputed by the defendant that the MS ISO 445, the defendant's pallet, P5, the plaintiff's pallet P11 comprise part of the common general knowledge of the person skilled in the art.

[67] Common general knowledge is important because it is an essential element in the consideration of, for example, obviousness in order to ascertain the validity of a patent. It is of significance to determine whether a person skilled in the art who is imputed with such common general knowledge would perceive a particular step as inventive or otherwise, and the sort of documents that he would have regard to.

[68] A person who professes to be skilled in the art but did not bother exhibiting his common general knowledge or where he derived such common general knowledge from is to be treated with caution.

[69] Bearing these principles in mind, we now go on to consider the evidence of PW3 and PW4.

THE EVIDENCE OF PW3 AND PW4

[70] PW3 in his testimony described the ordinary skilled but unimaginative addressee as follows:

> a person skilled in the art would be a person with qualification, technical know-how

A and working experience in manufacturing plastic environment specialize in manufacturing and design of pallets.

[71] He would be familiar with the Malaysian Standard ISO 445, describing it as a standard document that should be referred to. This would reflect the common general knowledge at the material time, namely prior to 27 July 2010.

[72] PW3 was next asked whether a person skilled in the art, using the Malaysian Standard ISO 445 would be able to design a pallet with the features in MY-055. His answer in examination-in-chief was as follows:

> As a person skill(ed) [sic] in the art, it is natural for a person to combine all these features. Because all these are common structures for all plastic pallets. So when we design the pallet, it is natural for him to combine all these features into one pallet to follow client's requirements.

And further on with respect to the design of a wing shaped pallet:

> Since this is a standard component [it] is simple for a normal person who has ordinary skill to combine all these into one pallet.

[73] In relation to whether one needs to be an inventor to design a pallet with the components in MY-055, PW3 stated:

> It is person with ordinary skill in the art to design such pallet.

[74] And further on in response to whether the features were new or inventive his reply was:

> No. After go [ing] (sic) all the claimed features are common structures of plastic pallets which are already used in the market. All these features had been disclosed in prior arts as listed in my table. And all the claimed inventiveness claimed here are not true because there is no scientific data or clear information for a person to verify the results.

[75] As pointed out earlier, PW3 maintained his stance in cross examination and PW4 essentially corroborated PW3's evidence.

THE EVIDENCE OF SD1

[76] We also considered the evidence of SD1 on this issue.

[77] In examination in chief, SD1, the inventor, explained what he considered to be the essential and novel features of MY-055 as shown below:

SD1	The 3 very important features that I have incorporated in this patented design is the protruding ribs around the chamfers around the entries of the channels, and the edges of the overhanging areas of the pallet, which provides enforcements to help strengthen the pallets against contact by the forklift. This is a new innovative design.
DC	Continue.
SD1	The 2nd one is the pallet base to incorporate unique horizontal members with treads to perform well in such environments in order to secure and move along the conveyor means smoothly and withstand the ultra-high point loads, like I explained to you earlier, point loads from the pitchers of rollers and chain conveyors. The third very important feature is the anti-slipping means underneath the studs and along the horizontal members and in the same flow with the treads in a measure to enhance the anti-slipping capabilities of the pallet during movement on the conveying means, general handling as well as during multiple stacking of the pallets throughout the whole life cycle of the pallets.
	...
SD1	Okay, in the patent specification, the essential features of my invention which are novel, No. 1 is the bottom structure of the wing shaped pallets, in the way the vertical and horizontal members are designed to incorporate plurality of treads at the bottom surface of the horizontal support members to permit efficient transportation of the loaded or unloaded wing shaped pallets by the use of conveying means. No. 2, the design of the wing shaped pallets incorporates a plurality of anti-slip means mounted on the top, the bottom of the planar platform as well as the vertically, the base of the wing-shaped pallets to prevent slippage of the pallets during handling and multiple stacking of loads, particularly bag products. And No. 3 is the design of the wing shaped pallets incorporating protruding ribs from the overhanging areas and the surface of the chamfers to reinforce the planar platforms and to guide the entry of the forktines across the chamfers.

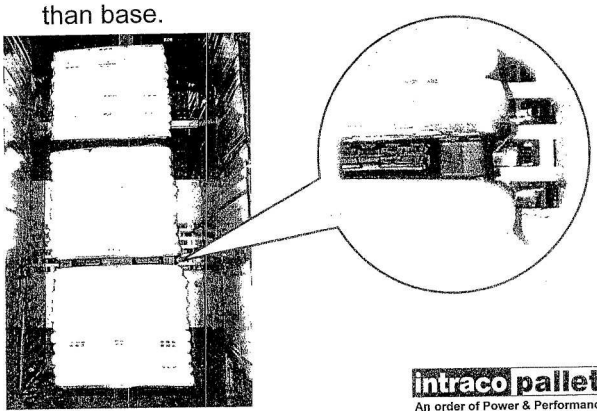
[78] We annex the features stated to be innovative and to provide solution according to SD1:

A

Solution:

❋ Wing-shape design, planar platform bigger than base.

B



C

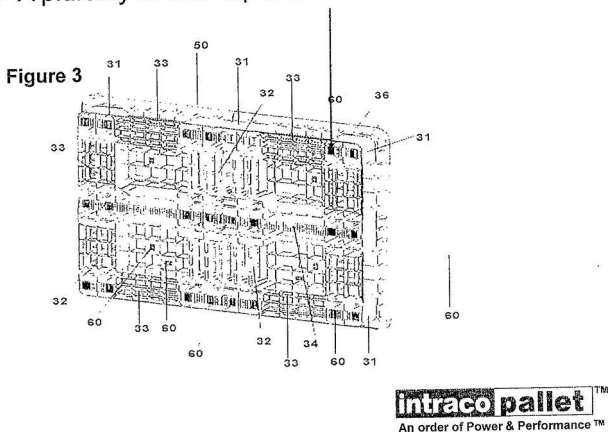
D

Solution:

E

❋ A plurality of anti-slip means

F



G

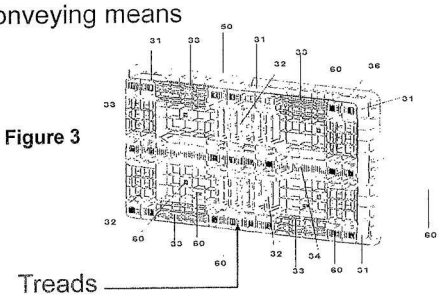
H

I

Solution:

- Plurality of treads on the bottom surface of the horizontal support member for producing friction between the said base and a conveying means

Figure 3



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[79] However, a perusal of the cross-examination of SD1 in its entirety discloses that he conceded that he did not invent treads nor anti-slip means, which are two of the essential features relied upon in MY-055. As for protruding ribs, SD1 disagreed that they existed in the form that he had utilised them in MY-055. He claimed that he was the inventor of protruding ribs to his pallet. This can be seen, inter alia, below:

SD1	I'm the inventor of protruding ribs to my pallets.
PC	To your pallets. But protruding ribs existed before 27.07.2010?
SD1	I don't know. As far as I know, there's none.
PC	Oh? There's none? Can I refer you to P10, which is the Malaysian Standards.
J	What page?
PC	Page 10. Figure 8. The drawing on the right hand side
DC	Which page?
PC	Page 10. Are you looking at the diagram?
SD1	Yes.
PC	Those protrusions at the bottom of the chamfer and the top of the chamfer, what are those?
SD1	You mean those ribs?
PC	Yeah, those are ribs right?
SD1	Okay. To me, that is not ...
PC	They're sticking out, aren't they? Are they protruding?
SD1	To me, that is not the chamfer. A chamfer is angled surface that guides the ... and protruding ribs on the angled surface is different from these kinds of structural ribs.
PC	What do you call the area the ribs are surrounding?

SD1	Those are structural ribs.
PC	Those are entries for the fork tines, right?
SD1	But that is not a chamfer. A chamfer is an angled surface.
PC	But it surrounds the entry for the fork lift, right?
SD1	But this area is a straight edged area, exposing these structural ribs that are there. A chamfer is like the bottom pallets, with the angled ...
PC	My question now is whether these are protruding ribs. Can we agree or can we not agree?
SD1	To me, these are not protruding ribs. It doesn't protrude. These are ribs, but it doesn't protrude out from the chamfer, it doesn't protrude out from the ...
PC	My question is not whether they protrude out from the chamfer. My questions are generally, are they protruding ribs? Do they stick out?
SD1	They are ribs.
PC	Are they sticking out?
SD1	All the ribs, you can see ...
J	Are they sticking out or are they not, yes or no?
SD1	No.
PC	They are not sticking out? Okay, if you insist. Can I refer you to your own pallet?
J	P4?
PC	P5, we're looking at P5. Mr. Cheah, can you look at your own pallet, P5? What do you call this?
SD1	These are ribs.
PC	Are the ribs flat? Are they hidden?
SD1	No.
PC	They're not hidden, right? Are they sticking out?
J	Are they protruding?
PC	He doesn't like the word protruding, so are they sticking out?
SD1	They're not sticking out from the pallet, they're within the structure of the pallet.
PC	But they're sticking out.
SD1	They're within the structure of the pallet. They're not protruding out from the surface of the pallet.
PC	They're protruding out from the top planar surface, aren't they?
SD1	What is ...
PC	This is the top planar surface, isn't it?
SD1	Yes.

[80] What constitutes an inventive step may depend on the nature of the invention. The matter was considered by Lord Hoffman in *Biogen Inc v Medeva plc* [1997] RPC 1 as follows:

> Whenever anything inventive is done for the first time it is the result of the addition of a new idea to the existing stock of knowledge. Sometimes, it is the idea of using

> established techniques to do something which no one had previously thought of doing. In that case the inventive idea will be doing the new thing. Sometimes it is finding a way of doing something which people had wanted to do but could not think how. The inventive idea would be the way of achieving the goal. In yet other cases, many people may have a general idea of how they might achieve a goal but not know how to solve a particular problem which stands in their way. If someone devises a way of solving the problem, his inventive step will be that solution, but not the goal itself or the general method of achieving it.

[81] It is clear that the existing protruding ribs design as found in MS-180445 serve exactly the same purpose or function as addressed by the defendant's invention in MY-055, and hence, there is no new solution to a problem that has been discovered by the defendant to be entitled to protection under MY-055.

APPLICATION OF THE WINDSURFING TEST

[82] In *Intellectual Property Law in Malaysia by Teh Pek San* published by Sweet & Maxwell, the learned author states at p 553 as follows:

> The first three steps essentially lay the groundwork for the court to direct itself in carrying out the objective of section 15, namely, whether the alleged invention involves an inventive step. Thus the application of the Windsurfing test in this country does not in any way conflict with section 15, but provides a structured approach to assessing obviousness ...

[83] Having taken guidance from PW3's evidence and having considered SD1's evidence, this court now has to assume the mantle of the normally skilled but unimaginative addressee in the art at the relevant date. Normally this step would be undertaken by the trial judge but we are constrained to do so as the evidence of the experts, namely PW3 and PW4 were erroneously excluded.

[84] Having done so and based on the entirety of the evidence on record, we are satisfied that MY-055 is obvious and does not embody or incorporate an inventive step. We so conclude for the following reasons:

(a) the notionally skilled but unimaginative addressee in the instant case would have knowledge of MS ISO 445. This comprises a part of the common general knowledge that may be imputed to the notional addressee; and

(b) the three essential features of MY-055 are contained in MS ISO 445. In any event S01 in his evidence (as shown above) conceded that treads and anti-slip means, as well as ribs per se, were not new and therefore not novel. The main contention of S01 is that the protruding ribs feature which is described as 'a plurality of protruding ribs to reinforce the planar

A platform and to guide the entry of the fork tines across the chamfers around the chamfers and overhanging areas' is a novel feature that distinguishes MY-055 from the prior art.

B **[85]** However, we are of the view that the use of such protruding ribs as described, is neither new nor inventive, as these functions of the ribs can be found in MS ISO 445.

C **[86]** Alternatively such protruding ribs can be designed from a perusal of the MS ISO 445 by the normally skilled but unimaginative addressee in the art at the relevant time. This is clear throughout PW3's evidence.

[87] Therefore viewed without any knowledge of MY-055, the essential features would be obvious to the skilled man.

D CONCLUSION

[88] Having applied s 15 of the PA and the test in *Windsurfing* we are satisfied that MY-055 is obvious and does not contain nor incorporate any inventive step.

E

[89] We agreed with the submission of learned counsel for the respondent that even if we were to find that the respondent/plaintiff's witnesses were not 'unimaginative skilled addressees', we may still refer to their evidence on technical terms and common general knowledge when assessing if the claims were obvious (see the Court of Appeal and Federal Court decisions in *SKB Shutters Manufacturing Sdn Bhd v Seng Kong Shutter Industries Sdn Bhd & Anor* [2015] 6 MLJ 293).

F

G **[90]** In any event, the respondent's witnesses have given evidence that they are designers of pallet industrial designs and not inventors of pallets. They have been involved only in the filing for industrial design protection for pallets, and never for patent protection for the pallets.

H **[91]** In arriving at this conclusion, we have borne in mind the position in law in relation to combinations of the three features, which appears to be the thrust of the defendant's case. In *British Celanese Ltd v Courtaulds Ltd* (1935) 52 RPC 171 at p 193, Lord Tomlin said:

I

> It is accepted as sound Jaw that a mere placing side by side of old integers so that each performs its own proper function independently of any of the others is not a patentable combination, but that where the old integers when placed together have some working interrelation producing a new or improved result then there is patentable subject-matter in the idea of the working interrelation brought about by the collocation of the integers.

Greene LJ stated in *Wood and Amcolite Ltd v Gowshall Ltd* (1936) 54 RPC 37 as follows:

> The dissection of a combination into its constituent elements, and the examination of each element in order to see whether its use was obvious or not, is ... a method which ought to be applied with great caution since it tends to obscure the fact that the invention claimed is the combination. Moreover, this method also tends to obscure the fact that the conception of the combination is what normally governs and precedes the selection of the elements of which it is composed, and that the obviousness or otherwise of each act of selection must in general be examined in the light of this consideration. The real and ultimate question is: is the combination obvious or not?

[92] In the instant case we are satisfied on a balance of probabilities that the combination of the three essential features is obvious and does not produce a new or improved result so as to give rise to a patentable claim in MY-055.

[93] In determining that MY-055 is not patentable we have also considered the evidence of SD2, the patent examiner. We found that he could not adequately justify the basis for registering the patent, MY-055.

CONCLUSION ON THE CROSS-APPEAL

[94] For the foregoing reasons, we are of the unanimous view that MY- 055 is invalid as it is not novel, as it is anticipated by prior art, and does not involve any inventive steps or ideas.

[95] We now turn to the appeal by the defendant.

THE APPEAL BY THE DEFENDANT

[96] The appeal relates to the grant of an amendment to prayer 19(c) of the statement of claim. Prayer 19(c) in its original form reads as follows:

> A declaration that the manufacture, importation distribution, stocking, supply, sale and/or offering to supply or sell the Plaintiff's wing-shaped pallets or any other pallets manufactured by the Plaintiff or its licensees or distributors does not constitute an infringement of any and all of the claims of Malaysian Patent No MY-148055-A.

[97] The effect of the amendment is to limit the declaration to only the plaintiffs wing-shaped pallet model N4–1311SLW, rather than all of the plaintiff's pallets. The learned judge then allowed the prayer as amended. This means that the plaintiff's model N4–1311SLW does not infringe MY-055.

[98] As we have concluded above that MY-055 is invalid, this issue is academic and redundant as the issue of the infringing of MY-055 no longer arises. The issue raised in this appeal is contingent upon the trial court's finding that MY-055 is valid. As we have found otherwise the matters in the appeal no longer arise for consideration. The net result is that the plaintiff is entitled to manufacture and supply wing-shaped pallets with or without protruding ribs in the course of its business. No question of limiting it to any one model arises, in any event.

FINAL ORDERS ON THE CROSS-APPEAL

[99] We order that the cross-appeal be allowed and the appeal be dismissed. The decision of the High Court is set aside and we grant prayers 19(a), (b), (c) and (d) only together with costs.

[100] The High Court costs are to be paid back. We award costs of RM150,000 to the respondent here and below subject to allocatur.

Order accordingly.

Reported by Kohila Nesan